

REMARKS/ARGUMENTS

Claims 1-24 remain in this application.

Rejection Under 35 USC 103

Claims 1-24 remained rejected under 35 USC 103 as being unpatentable over Shukuzaki et al. (U.S. Patent No. 5,266,321) in view of Sunkel et al. (U.S. Patent No. 6,542,598). See Pages 2-4 of the Office Action. Applicants respectfully disagree for the same reasons as previously stated in the Response filed on December 19, 2003 ("Prior Response").

In response to the Applicant's arguments made in the Prior Response, the Office Action states that they were found unpersuasive. See Page 4 of the Office Action. First, the Office Action states that "the incorporation of polysiloxane elastomers in various forms of cosmetics are deemed to be functionally equivalent (e.g., foundation, eye shadows, powders, and mascaras)." See Page 5 of the Office Action. Applicants respectfully disagree. No support for this contention is set forth in the Office Action. Also, Applicants do not agree that cosmetics always use the same ingredients. For example, a powder is functionally very different from a mascara.

Second, the Office Action states "applicants arguments that Sunkel does not teach less than about 1% by weight of wax is not persuasive, since, generally, differences in concentrations or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. . . . Applicants have not shown that the small amount of difference in wax percentages between the prior art and the instant claims are a crucial difference." See Pages 5-6 of the Office Action. Applicants again respectfully disagree. As stated in the Prior Response, the mascara set forth in Example II of Sunkel et al. comprises 11.25% of wax (i.e., 3%, by weight, of caruba wax, 3.75%, by weight, of white beeswax, 2.25%, by weight, of paraffin wax 118/125, and 2.25%, by weight, of paraffin wax). Thus, Sunkel et al. does not teach, nor suggest, the mascara recited in independent claim 1 of the present application, which "comprises less than about 1%, by weight, of wax." Rather, Sunkel et al discloses a

mascara that comprises about 10 times more wax. Applicants contend that this is not a “small amount of difference” as set forth in the Office Action.

As stated in the Prior Office Action, PCT Patent Application No. WO00/74519 (the ‘519 Application”) (attached to the Prior Response), assigned to Revlon Consumer Products Corporation, a major marketer of mascaras recites on page 1, line 13-22, “A ‘gold standard’ mascara should provide optimal length, color, thickness, and curl to the lashes. . . . One key ingredient in mascara formulas, namely wax, is believed to play a role in achieving all of the attributes mentioned above. That is why virtually all mascaras contain wax. However, waxes provide certain undesirable properties. In particular, waxes cause mascaras to increase in viscosity in storage . . . sometimes to a level which makes it difficult to use and apply. This causes problems for manufactures because such mascaras have reduced shelf life.” Thus, the reduction of the amount of wax in a mascara is important.

The Office Action also states that the “instant claims do not recite a mascara that is ‘wax-free.’” See Page 6 of the Office Action. Applicants respectfully disagree, as claims 13-24 of the present application all recite that “said mascara does not comprise wax.”

Lastly, the Office Action states that the ‘519 Application teaches that the use of wax (2.0 & 1.8%) which is greater than the ‘less than about 1% by weight of wax’ as instantly claimed, the particular amounts incorporated by the prior art would not be considered to be detrimental to the mascara formulation itself, but rather would be deemed suitable and effective amounts of wax that would not contribute to any major undesirable drawbacks.” The Applicants do not contend that mascaras that contain amounts greater than 1% by weight of mascara would not be effective. Rather, the Applicants refer to the ‘519 Application just to support the point that, as stated above, waxes provide certain undesirable properties, and thus the minimization or removal of the incorporation of waxes from the mascara would be desirable and beneficial.

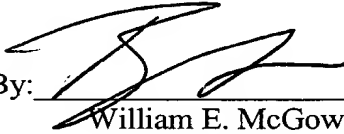
Accordingly, Applicants respectfully request that the above rejection under 35 USC 103(a) be withdrawn.

Please note, Applicants also still respectfully request acknowledgement of receipt of the Second Supplemental Information Disclosure Statement filed August 30, 2003.

Serial No. 09/938,454

Applicants also respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

By: 

William E. McGowan
Reg. No. 39,301

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2197
Dated: July 23, 2004